

Attorney Docket No.: 10179.204-US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Schneider et al.

Confirmation No: 4404

Serial No.: 09/869,877

Group Art Unit: 1652

Filed: July 6, 2001

Examiner: E. Slobodyansky

For: Laccase Mutants

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CERTIFICATE OF FACSIMILE TRANSMISSION

Commissioner for Patents
Washington, DC 20231

Sir:

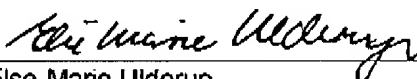
I hereby certify that the attached correspondence comprising:

1. Response to Restriction Requirement

was sent to the United States Patent Office by telefax to the attention of Examiner E. Slobodyansky, fax number (703) 872-9306.

Respectfully submitted,

Date: June 11, 2004



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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Office Action mailed May 19, 2004. The Action made a restriction requirement between the following groups:

Group I – claims 16-34 and 36-42 drawn to laccase variants and detergent compositions comprising same;

Group II – claims 43-45 drawn to methods of use of laccase variants.

The Office Action also requested that Applicants elect a position for substitution from positions 52, 121, 141, 206, 336, 365, 380, 382, 406, 506, and 507.

Applicant respectfully traverses both the restriction and election of species requirements.

The above-captioned application was entered into the national stage under 35 U.S.C. 371, i.e. filed via the PCT. For these types of applications, the PTO follows the rules set forth in 37 C.F.R. 1.401 - 1.499.

The standard for determining whether unity of invention exists during the national stage, i.e. whether a restriction requirement may be imposed, is set forth in 37 C.F.R. 1.475(a) which provides:

An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.... Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Moreover, under 37 C.F.R. 1.475(b), an international or a national stage application in the national stage complies with the unity of invention requirement if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specially designed for carrying out the said process.

In the present case, the invention designated I is directed to the variants and the invention designated II is directed to methods of using the variants. Thus, the two sets of claims are related as product and a process of use of said product. Thus, under 37 C.F.R. 1.475(b)(2), the U.S. Patent and Trademark Office is required to examine these claims in a single U.S. national phase application.

Moreover, no objection to unity of invention was raised at any point of the PCT prosecution by either the International Searching Authority or the International Preliminary Examining Authority.

Moreover, election of species requirements are not permitted in U.S. national phase applications. Applicants note that Applicants have filed numerous patent applications on variants and all other Examiners examine all of the positions in a single application.

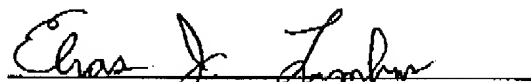
Applicant, therefore, respectfully submits that the restriction and election of species requirements are improper. Applicant respectfully requests reconsideration and withdrawal of the requirements.

In order to be fully responsive, Applicants hereby elect the invention of Group I, and the species of position 121. Claims 16, 19, 20, and 39-45 read thereon. Applicants hereby reserve the right to file continuing applications directed to the nonelected subject matter.

The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

Date: June 11, 2004


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